

REMARKS

Prior to entry of this Response, Claims 1-19 were pending and under consideration. With this Response, no claims have been amended or cancelled. Thus, after entry of this Response, Claims 1-19 are pending and under consideration.

Rejection of Claims 1-2, 6-7, 9, 13, 17 and 18 Under 35 U.S.C. § 102(b)

Claims 1-2, 6-7, 9, 13, 17 and 18 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Wortham (US 4,750,636).

The rejection is traversed as applied to claims 1-2, 6-7, 9, 13, 17 and 18 on the ground that the cited reference fails to teach each and every limitation of the rejected claims. To anticipate a claim under 35 U.S.C. § 102(b), a reference must teach every element of the rejected claim (MPEP § 2131).

All of the rejected claims recite the limitation of a closure defining at least one “slit”. As discussed in the Interview Summary dated Aug. 18, 2005, the Examiner agreed that the rejection under 35 U.S.C. § 102(b) would be withdrawn.

Rejection of Claims 19 Under 35 U.S.C. § 103(a)

Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentably obvious over Wortham.

The rejection is traversed as applied to Claim 19 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

In rejecting claims under §103(a), the Patent Office bears the burden of establishing a *prima facie* case of obviousness (MPEP § 2142). To establish a *prima facie* case, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine their teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest each and every limitation of the rejected claims. The teaching or suggestion to make the claimed combination *and* the reasonable expectation of success must *both* be found in the prior art, and *not* in Applicants' disclosure. *In re*

Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2142.

The references fail to teach each and every limitation of the rejected claim. Claim 19 depends ultimately from Claim 13 which recites the limitation of a closure defining at least one “slit” As noted above, this limitation is not shown in Wortham. There is no motivation in Wortham to utilize a slit. The opening in Wortham is round (17 in FIG. 1), and is intended to provide an opening for a test tube blood container (see 22 in FIG. 2). A slit opening would not provide a close fit opening around the test tube , and would therefore defeat the purpose of Wortham which is to contain aerosols and to minimize contamination.

The cited reference therefore fails to teach or suggest each and every limitation of the rejected claim. Accordingly, *prima facie* obviousness is not established and the rejection of Claim 19 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Claims 3-4, 14 and 15 Under 35 U.S.C. § 103(a)

Claims 3-4, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentably obvious over Wortham in view of Tyree (US 2001/0035414).

The rejection is traversed as applied to Claims 3-4, 14 and 15 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

The references fail to teach each and every limitation of the rejected claim. The claims depend from claim 1 or from claim 13 which recite the limitation of a closure defining at least one “slit” As noted above, this limitation is not shown in Wortham. There is no motivation in Wortham to utilize a slit. The opening in Wortham is round (17 in FIG. 1), and is intended to provide an opening for a test tube blood container (see 22 in FIG. 2). A slit opening would not provide a close fit opening around the test tube , and would therefore defeat the purpose of Wortham which is to contain aerosols and to minimize contamination. The use of a slit in Wortham would therefore defeat the purpose of the reference.

Since Wortham does not teach a slit, it cannot be modified to have intersecting slits as shown in Tyree as alleged by the Patent Office.

Therefore, the cited references alone, or in combination, fail to teach or suggest each and

every limitation of the rejected claims. Accordingly, *prima facie* obviousness is not established and the rejection of Claims 3-4, 14 and 15 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Claims 8 and 10-12 Under 35 U.S.C. § 103(a)

Claims 8 and 10-12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentably obvious over Wortham in view of Lovelace (US 6,036,038).

The rejection is traversed as applied to Claims 8 and 10-12 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

The references fail to teach each and every limitation of the rejected claim. The claims depend from claim 1 which recites the limitation of a closure defining at least one “slit”. As noted above, this limitation is not shown in Wortham. There is no motivation in Wortham to utilize a slit. The opening in Wortham is round (17 in FIG. 1), and is intended to provide an opening for a test tube blood container (see 22 in FIG. 2). A slit opening would not provide a close fit opening around the test tube, and would therefore defeat the purpose of Wortham which is to contain aerosols and to minimize contamination.

Therefore, the cited references alone, or in combination, fail to teach or suggest each and every limitation of the rejected claims. Accordingly, *prima facie* obviousness is not established and the rejection of Claims 8 and 10-12 under 35 U.S.C. § 103(a) should be withdrawn.

Rejection of Claims 5 and 16 Under 35 U.S.C. § 103(a)

Claims 5 and 16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentably obvious over Wortham in view of Lovelace (US 6,036,038).

The rejection is traversed as applied to Claims 5 and 16 on the ground that the Patent Office has failed to establish a *prima facie* case of obviousness.

The references fail to teach each and every limitation of the rejected claim. The claims depend from claim 1, or from claim 13, which recite the limitation of a closure defining at least one “slit”. As noted above, this limitation is not shown in Wortham. There is no motivation in

Wortham to utilize a slit. The opening in Wortham is round (17 in FIG. 1), and is intended to provide an opening for a test tube blood container (see 22 in FIG. 2). A slit opening would not provide a close fit opening around the test tube , and would therefore defeat the purpose of Wortham which is to contain aerosols and to minimize contamination.

Therefore , the cited references alone, or in combination, fail to teach or suggest each and every limitation of the rejected claims. Accordingly, *prima facie* obviousness is not established and the rejection of Claims 5 and 16 under 35 U.S.C. § 103(a) should be withdrawn.

Conclusion

Applicant submits that Claims 1-19 satisfy all of the statutory requirements for patentability and are in condition for allowance. An early notification of the same is kindly solicited.

Respectfully submitted,
FOOTHILL LAW GROUP, LLP

Date: Dec. 13, 2005 /John F. Brady/
By: John F. Brady
Reg. No. 39,118

FOOTHILL LAW GROUP, LLP
3333 Bowers Ave., Suite 130
Santa Clara, CA 95054
Phone: 408-293-0880